

## REMARKS

Claims 1-24 and 26 are pending in the application. Claims 1, 13, 20, and 26 are independent claims. This amendment amends claim 1 and adds claim 27. Support for new claim 27 can be found at page 23 et seq. of the specification.

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which applicant regards as the invention. Claim 1 has been amended to remove the antecedent basis problem regarding "said representations". The amendment does not affect the scope of the claims.

Claims 1, 2, 10, 11, 14, and 22 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Mosher.

On November 14, 2001, an attorney for the Applicant spoke by telephone with the Examiner regarding the Mosher reference and why Mosher does not teach encoding a non-text document into Internet compatible email. Fleming was also discussed insofar as an HTML document is merely a text document. It was explained that HTML documents do not contain graphics but merely contain pointers to the location of graphic files. Moreover, as stated previously, the creation of an HTML file with a pointer to a graphic file is not the same as the creation of the graphic file. Claim 1

requires "creating the other than text portion of the document". The HTML editor in Outlook Express does not create a graphic although it may point to a graphic created by some other program. HTML is text only. Indeed, HTML stands for hyper text markup language.

The Examiner states in paper Number 12 that Mosher discloses "creating the other than text portion of the document", referring to information fields, text boxes, visual basic script language, etc. However, as previously stated, the non-text portions of documents created by Mosher are not able to be encoded into Internet-compatible email messages.

During the November 14, 2001 telephone conference, the Examiner indicated that he believed that the last bullet point on page 2 of Mosher indicated that email created with the forms templates in Outlook could be sent over the Internet.

It was explained to the Examiner that the Mosher reference never mentions the Internet, not all email is Internet compatible, and not all Web sites are accessed via the Internet. It was further explained that publishing a form template was not the same as sending an email created with the template.

The email with templates discussed in Mosher is intended for use on a local area network, not the Internet. The example given

by Mosher is telling. It is a phone message which would be taken by a secretary and given to the secretary's boss, typically located less than one hundred feet away. This kind of intra-office email uses a LAN but does not use the Internet.

In order for the Microsoft Outlook e-mail client to receive an email which looks like Figure 18.5 of Mosher, the sending e-mail client and the receiving e-mail client must be connected to the same Microsoft e-mail server. Although this is not specifically stated in the Mosher reference. There is nothing stated in the Mosher reference which suggests otherwise.

It is respectfully submitted that the Mosher document relates to technology described in U.S. Patent Number 6,035,327 which was filed on December 8, 1997. Microsoft's proposed solution to the text limitation of the Internet was not to make non-text messages Internet compatible, but rather to change the Internet.

It is well known that Internet email was originally designed to handle text messages only. In the words of Microsoft in December 1997:

"For example, until recently the Internet supported only plain text messaging. In contradistinction, many corporate LANs and other networks supported a wide variety of rich text and other formatting features and allowed a wide variety of information to be

exchanged among users." Col. 1, line 53 et seq. of the '327 patent.

"[M]any networks allow users to define information that is carried along as part of an email message in one or more custom data fields. Such custom information is lost when a message is transferred over the Internet due to the lack of support for custom information in the STMP protocol and the 822 mail message." Col. 2, line 39 et seq. of the '327 patent.

From the foregoing, it should be apparent that at the time the Mosher document was published, Microsoft was telling the Patent Office that non-text content would be lost when mail is sent over the Internet. In particular, the "custom data fields" taught by Mosher would be lost if mail were sent over the Internet.

In Paper Number 12, the Examiner has replied that "[t]he custom information described in the 327 patent is not the same as the templates taught by Mosher." However, the Examiner does not offer any support for making this conclusion other than to state that "Mosher teaches that forms created by Microsoft Outlook were sent via email, and goes on to say that forms were to be sent and published on an Internet Web site without any mention of loss." [Emphasis supplied by the Examiner.] As mentioned above, Mosher never uses the word Internet.

As explained above, the Examiner's analysis of Mosher is faulty because it assumes that all email is Internet compatible and that all Web sites are accessed via the Internet. Further, the Examiner's analysis assumes that publishing a form is the same as sending an email created with the form. This is clearly not the case. Publishing a document on a Web site is typically effected with an FTP client and certainly not with an email client. Further, retrieving a published document from a Web site is also effected with an FTP client, although many today's browsers include an FTP component which may be referred to as a "download manager". In any event, publishing something on a Web site has nothing to do with email.

Thus, when read carefully with an understanding of how the Internet worked in 1997, the Mosher reference does not teach or suggest the claimed invention. Moreover, documentary evidence contemporaneous with the Mosher reference suggest that the Applicant's interpretation of Mosher is correct. An object of the '327 patent is to overcome the limitation which prevents the non-text content created with Outlook from being carried over the Internet. Microsoft's solution to the problem was to change the Internet. The '327 patent proposes adding certain extensions to the SMTP protocol so that Outlook e-mail containing non-text content can be carried over the Internet without losing the non-text content. This is not making Outlook e-mail Internet compatible. It is making the Internet Outlook compatible. It

should be appreciated that the Microsoft solution proposed in December 1997 would have required alterations to every e-mail server on the Internet. The present invention does not require any changes to the Internet. The present invention uses the Internet as is to send documents containing non-text information without losing any information in transit.

In addition to the reasons related above, it is the Applicant's position that Mosher and Fleming are not properly combinable. The Examiner's stated incentive for combining these two programs is "because Mosher teaches: 'design forms can do almost anything you can imagine in Outlook'". It is not clear to the Applicant why that statement would give someone an incentive to combine Outlook and Outlook Express. On its face, it would seem that that statement would be intended to persuade one to use Outlook rather than Outlook Express.

For the Examiner's reference, it should be remembered that Fleming is discussing a feature of the Microsoft Web browser, i.e. a simplified email component called Outlook Express. It is not the full featured Microsoft email program called Outlook. Because Outlook Express is a component of Microsoft's Web browser, it has access to an HTML interpreter. Thus, some simple HTML tags can be included in email messages. As mentioned above, there is no authoring component for creating something which is not text. HTML is text.

Outlook and Outlook Express take two completely different, and fundamentally opposed, approaches to the problem of extending the capabilities of mail client software. Because the rationale between the two approaches is so different, it is unnatural and counterintuitive to translate Outlook forms into HTML encoding as used by Outlook Express for transport across the Internet. The rationale behind Outlook Express is diametrically opposed to the notion of "a plurality of authoring components".

Outlook Express was designed so that all messages could be represented with a single message encoding format - HTML. It was believed that HTML was a language with expressive power sufficient to represent any document that one would want to send via email. The design commitment in Outlook Express to a single authoring tool based on HTML was so complete that even simple text messages were converted by Outlook Express into HTML. This was because the single message reading component in Outlook Express could only process HTML.

Outlook, on the other hand, was designed to support the use of forms which the Examiner considers to be "a plurality of authoring components". Each form was intended to be custom built to handle a very particular communication need or to gather very specific information, in a very specific format, from its recipients. Although the tools used to create the forms, i.e. Outlook Forms designer, by necessity generated similar underlying

code, the forms themselves were assumed to be unique. In Outlook, a message authored using a particular form can only be displayed by the recipient if the recipient has a copy of the form used to create the message. The notion of having a single generic authoring/reading component that can handle all messages is contrary to the design goals of Outlook.

It should be noted that these two programs, Outlook and Outlook Express, have been developed and supported as two separate products over many years by the same company, Microsoft. During this time, Microsoft has made every effort to shift users from Outlook Express to Outlook by including Outlook as the mail client in the Office Suite and by focusing marketing efforts on Outlook rather than Outlook Express. Microsoft would have merged the capabilities of these two products years ago, were there any incentive to do so. In fact, there is no such incentive.

Claims 2, 10, and 11 depend from claim 1 and the arguments made above apply to these claims as well. Moreover, with regard to claim 2, the Applicant contends that a spell checker is not an authoring component for creating anything. It can only be used to modify something already created.

Claim 20 is of similar scope to claim 1 and the arguments made above apply to this claim as well.



Claim 22 depends from claim 20 and the arguments made above apply to this claim as well.

Claims 3, 4, 8, 9, 12, 21, and 26 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Mosher in view of Wolf et al.

Claims 3, 4, 8, 9, and 12 depend from claim 1 and thus include all of the limitations of claim 1 are included in these claims. In particular they include the limitation that the e-mail containing non-text content be Internet compatible.

It has been established in the remarks made above that as of 1997 Microsoft mail containing non-text would have the non-text portion removed when sent over the Internet. The e-mail described in the Wolf et al. patent suffers from this same problem since the Wolf et al. disclosure was made in 1996 by Microsoft.

Claim 21 depends from claim 20 and the remarks made above regarding claim 20 apply to this claim as well.

Regarding claim 26, the remarks made above regarding Internet compatibility apply to claim 26 as well.

In reference to claim 26, the Examiner repeats his remarks that Mosher teaches "design forms can do almost anything you can

imagine in Outlook". It is not sure what the Examiner intends by citing this portion of Mosher because it essentially teaches nothing. Stating that you can do anything you can imagine is an invitation to invent, not a teaching of what you can do.

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Bradshaw et al.

Claim 13 claims that an authoring component includes means for determining whether the user is a teacher or a student. This is not the same as distinguishing between author and reader because students can send and receive e-mail to and from teachers. Nor is this the same as a user looking at the name of an email author and determining whether the author is a teacher or a student. Claim 13 requires that an authoring component include means for determining whether the user is a teacher or a student. This feature allows teachers to have access to certain authoring features which are not available to students and vice-versa if desired.

The Examiner cites col. 3, lines 30-67 and col. 4, lines 16-67 of Bradshaw et al. as teaching an authoring component which includes means for determining whether the user is a teacher or a student. Bradshaw et al. broadly teach limiting Internet access by means of a TSR (terminate and stay resident) program which filters whatever is sent through winsock. This does not amount to

teaching an authoring component which includes means for determining whether the user is a teacher or a student.

Claim 14 depends from claim 13 and the remarks made above regarding claim 13 apply to claim 14 as well.

Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming, in view of Bradshaw et al., further in view of Wolf et al.

Claims 15 and 16 depend from claim 13 and the remarks made above regarding claim 13 apply to claims 15 and 16 as well.

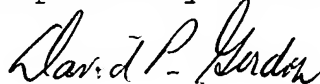
Claims 5-7, 23, and 24 stand rejected under 35 U.S.C. §103(a) as obvious over Fleming in view of Mosher further in view of Hong et al.

These claims all depend from claims discussed above and to that extent the remarks made above regarding claims 1, 13, and 20 apply to these claims as well. Furthermore, the fact that Hong et al. utilizes the MIME standard to one end does not teach or suggest using that standard to achieve the results of the invention which clearly were not possible at the time Hong et al. was filed, i.e. sending an e-mail with non-text content over the Internet without losing the non-text content.

New claim 27 has been added. Claim 27 fairly claims one of the features of the invention discussed with the Examiner today by telephone. According to one of the aspects of the invention, the email client automatically determines the type of reading component needed to read an email document and opens the document with the appropriate reading component.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,



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1. (three times amended) An electronic mail client, comprising:
  - a) a plurality of authoring and reading components, a first of said plurality of authoring components for creating a representation of a document including an other than text portion and for creating the other than text portion of the document;
  - b) encoding means for automatically encoding said [representations] representation created with said authoring components into an Internet-compatible email message; and
  - c) decoding means for automatically decoding said [representations] representation encoded by said encoding means.